

**UNITED STATES DEPARTMENT OF COMMERCE****United States Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

AS

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/957, 187 10/24/97 BEER

E 514425-3566

020999
FROMMER LAWRENCE & HAUG
745 FIFTH AVENUE
NEW YORK NY 10151

IM71/0509

 EXAMINER

AHMED, S

ART UNIT	PAPER NUMBER
----------	--------------

1773

17

DATE MAILED:

05/09/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No. 08/957,187	Applicant(s) Beer et al.
	Examiner Sheeba Ahmed	Art Unit 1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Apr 3, 2001

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 1035 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 10-23 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 10-23 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). 12

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

Art Unit: 1773

DETAILED ACTION

Continued Prosecution Application

1. The request filed on April 3, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/957,187 is acceptable and a CPA has been established. An action on the CPA follows.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 10-14 and 17-23 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Hirose et al. (US 5,532,030).

Hirose et al. disclose a multilayer laminate in which sheets or film based on polyolefins are laminated to form a material for packing. The multilayer laminate comprises a layer made from at least one cycloolefin-based resin selected from the group consisting of (a1) an ethylene/cycloolefin random copolymer obtained by polymerizing a cycloolefin (represented by the formula (1) or (2)) with ethylene, (a2) a ring-opening polymer of the cycloolefins or its hydrogenation product and (a3) a graft-modification product of (a1) or (a2) (Column 1, lines 13-16, 54-64 and Column 2, lines 1-5). The structure of the cycloolefin component is given in Column 2 wherein *n* may be

Art Unit: 1773

zero or 1, m may be zero or any positive integer, q may be zero or 1 and the substituents R_1-R_{18} may be a radical selected from the group consisting of hydrogen atom, halogen atom and hydrocarbon groups and wherein the R groups may form a monocyclic or polycyclic ring by combining with each other. The halogen atoms may be fluorine, chlorine, bromine or iodine and the hydrocarbon groups may be C_1-C_{20} alkyl groups, C_1-C_{20} halogenated alkyl groups, C_3-C_{15} cycloalkyl groups and C_6-C_{20} aromatic hydrocarbons (Column 4, lines 8-25). The ethylene/cycloolefin random copolymer usually contains the constituent unit derived from ethylene in an amount of 52-90 mole % and the constituent unit derived from a cycloolefin in an amount of 10-48 mole%. The ethylene/cycloolefin copolymer may contain constituent units derived from other copolymerizable monomers such as monocyclic olefins in an amount of 20 mole % or less (Column 21, lines 64-67, Column 22, lines 1-4, 66-67, Column 23, lines 31 and Column 24, lines 1-2). The cycloolefin-based resin may be blended with other resins and various additives (Column 29, lines 56-67). The multilayer laminate may be subjected to monoaxial or biaxial stretching to produce a sheet or film material suitable for packaging drugs, foods and cigarettes. Such a material has superior moisture-proof properties and therefore may be used as a blister pack, bottle or other type of container (Column 34, lines 33-67 and Column 35, lines 1-19). The thickness of the laminate is 100 microns as indicated in Table 1 in Columns 35 and 36. With regards to the limitations of the water vapor permeation, puncture resistance, film elongation at break, and film tear strength value in machine direction, the Examiner takes the position that these properties are inherent in the multilayer laminate disclosed by Hirose et al. given that the composition and

Art Unit: 1773

structure of the laminate disclosed by Hirose et al. and the laminate of the claimed invention are identical. All limitations of the claimed invention are either inherent or disclosed in the above reference.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030).

The above rejection is maintained for the reasons of record as set forth in paragraph No. 6 of the Office Action mailed on September 1, 1999 (Paper No. 7).

4. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of Tanaka et al. (U.S. 5,556,920).

The above rejection is maintained for the reasons of record as set forth in paragraph No. 7 of the Office Action mailed on September 1, 1999 (Paper No. 7).

Art Unit: 1773

Response to Arguments

5. Applicants traverse the rejection of claims 10-14 and 17-23 under 35 U.S.C. 102(b) as being clearly anticipated by Hirose et al. (US 5,532,030), the rejection of claim 15 under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030), and the rejection of claim 16 under 35 U.S.C. 103(a) as being unpatentable over Hirose et al. (US 5,532,030) in view of Tanaka et al. (U.S. 5,556,920) and submit that the claimed invention possesses a specific set of properties, i.e., water permeation, puncture resistance and thickness, wherein the puncture resistance of the films is obtained by a selected processing of the film, and such properties or procedure to obtain such properties are neither disclosed nor obvious from the Hirose reference. Applicants further allege that if the correct stretching conditions are not chosen properly, the claimed puncture resistance is not achieved. However, as previously pointed out in the Office Action mailed on May 1, 2000 and as stated above in Paragraph No. 2, the Examiner has taken the position that these properties are inherent in the multilayer laminate disclosed by Hirose et al. given that the composition and structure of the laminate disclosed by Hirose et al. and the laminate of the claimed invention are identical. Although, the Applicants allege that specific processing is required to obtain the necessary water permeation and puncture resistance, the *Applicants have failed to provide any experimental data or other objective evidence to support the assertion that such processing leads to a materially different product than the one disclosed by Hirose.* Thus, the Examiner maintains that the claimed water vapor permeation and puncture resistance are inherent properties of the laminate disclosed by Hirose. Applicants are reminded

Art Unit: 1773

that once the Examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to Applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product.

Applicants further allege that Hirose only generally mentions that their films can be stretched mono- or biaxially and Hirose relates only to multilayer film whereas the present invention teaches and claims both mon- and multilayer films. Again, as previously pointed out in the Office Action mailed on May 1, 2000 and as stated above in Paragraph No. 2, the Examiner wishes to direct the Applicants attention to Columns 34 and 35 which *specifically state* that the multilayer laminate may be subjected to monoaxial or biaxial stretching to produce a sheet or film material suitable for packaging drugs, foods and cigarettes. Furthermore, the Examiner would like to point out that the use of open-claim language in the claims of the instant application, i.e., *comprising*, does not preclude the presence of other layers or elements in the laminate.

Hence, the rejections of record are maintained.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

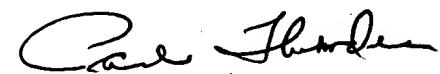
Art Unit: 1773

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sheeba Ahmed whose telephone number is (703) 305-0594. The Examiner can normally be reached on Monday-Friday from 8am to 5pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Paul Thibodeau, can be reached at (703) 308-2367. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-5436.


Sheeba Ahmed
May 7, 2001


Paul Thibodeau
Supervisory Patent Examiner
Technology Center 1700